

REMARKS

This Amendment is in response to the Office Action dated August 27, 2004.

Claims 1-40 were pending in this application. Previously, claims 14-19 and 27- 40 were withdrawn from consideration in view of an earlier election of species requirement. By this Amendment, Applicants have canceled claims 1, 2 and 33-40 without prejudice.

Claim 3 has been rewritten in independent form and amended to recite a “delivery device” rather than a “delivery catheter” in the preamble. Claims 10, 20 and 21 have been amended to depend from claim 3. New claims 41-51 are being presented. Favorable reconsideration of all the pending claims is respectfully requested.

The Examiner rejected claims 1, 2 and 20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,544,279 to Hopkins et al. (the “Hopkins patent”). In view of Applicants’ cancellation of claims 1 and 2 without prejudice and the amendment of claim 20 to depend from claim 3, this rejection should now be withdrawn by the Examiner.

The Examiner has rejected claims 3-13 and 21-26 under 35 U.S.C. § 103(a) as being unpatentable over the Hopkins patent in view of U.S. Patent No. 6290,710 to Cryer et al. (the “Cryer patent”). Applicants respectfully submit that the Cryer patent and the present application were, at the time the presently claimed invention was made, each either owned by, or subject to, an obligation of assignment to Advanced Cardiovascular Systems, Inc. Applicants direct the Examiner’s attention to the recorded assignment of the present invention to Advanced Cardiovascular Systems, Inc., which is recorded at Reel/Frame 011971/0220 on June 29, 2001. The present application was filed after the November 22, 1999 effective date of change to 35 U.S.C. § 103(c) which disqualifies § 102(e) prior art from consideration under § 103 if the subject matter of the reference and the claimed invention were commonly owned at the time the claimed invention was made. The Cryer patent constitutes a § 102(e) reference and has been cited in the current Office Action as a § 103(a) reference. Applicants have made herein a statement that the Cryer patent and the present application were, at the time the invention was made, each

either owned by or subject to an obligation of assignment to the same company. In view of this statement of common ownership, Applicants respectfully asserts that the Cryer patent is not a valid 35 U.S.C. § 103 (a) reference and traverse the current rejections. MPEP 706.02 (l) (2).

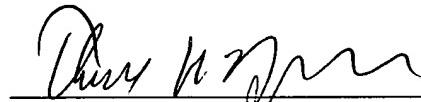
Applicants respectfully request the Examiner to withdraw the U.S.C. § 103(a) rejection as applied to claims 3-13 and 21-26 since all rejections are based on the combination of the Cryer patent with the Hopkins patent. Without the teachings of the Cryer patent, the combination of the other references simply fails to achieve the claimed structure of the pending claims.

In view of the foregoing, it is respectfully urged that all of the present claims of the application are patentable and in a condition for allowance. The undersigned attorney can be reached at (310) 824-5555 to facilitate prosecution of this application, if necessary.

In light of the above amendments and remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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